

## **REMARKS**

This responds to the Office Action mailed on November 17, 2009. Claims 1, 21, 36, 38-40, 41-42, and 45-48 are amended, claims 5-6 and 9 are canceled, and no claims are added; as a result, claims 1-4, 9-10, 17, 21, , 26, and 31-56 are now pending in this application.

### **Claim Objections**

Claims 1, 36, 38-40, and 46-48 were objected to because of misspelling informalities. Applicant has amended these claims as suggested by the Examiner.

Claims 5 and 6 were objected to for improper dependency for failure to further limit the independent claim. Claims 5 and 6 have been cancelled to obviate the objection.

Claim 31 was objected to for improper dependent form. Applicant has amended the preamble of independent claim 1. Applicant respectfully submits that dependent claim 31 is no longer in improper form.

Reconsideration and withdrawal of the claim objections are respectfully requested.

### **Double Patenting Rejection**

Claims 1, 21, 31-36, and 38-39 were rejected under the judicially created doctrine of double patenting over claims 1, 3, 19-21, 27-31 and 33-34 of U.S. Patent No. 6,733,582. Applicant respectfully traverses the Double Patenting rejection for at least the following reasons.

The rejection states that “although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a composition comprising a calcium phosphate particle such as alpha-tricalcium phosphate (‘582 claim 3) with an overlapping particle size of 100-250 microns (‘582 patent claims 27-29), overlapping Ca/P ration of 1-2 (‘582 patent claims 33-34 (Ca/P 1-1.67)), and hyaluronic acid or hyaluronate salts, etc.”

Without addressing the above listed properties, Applicant respectfully submits that the present claims include a number of distinguishing limitations. For example, Applicant cannot

find in the '582 patent claims any recitation of a porous structure in particle, or use of a hydrogel, or particles having a non-spheric shape.

Because the '582 patent claims do not recite or make obvious every element of Applicant's independent claims, a Double Patenting rejection is not supported. Reconsideration and withdrawal of the Double Patenting rejection are respectfully requested.

§112 Rejection of the Claims

Claim 21 was rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Applicant has amended the claim to more clearly recite only device limitations. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1 and 9 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The rejection notes certain pore size ranges that include impossible combinations. Applicant has amended claim 1 to remove pore size ranges, and cancelled claim 9, thus rendering the rejection with respect to pore size moot. Applicant has further removed the limitation reciting "jarring density." Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 36 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The rejection states that polysaccharide is a broad recitation, and that other narrow recitations were included within the broad category. Applicant has amended claim 36 to remove the suggested narrower ranges. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 41-42 and 48 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The claims in question recited a broad range, and a preferred narrower range. In order to obviate the rejection, Applicant has amended claim 41-42 and 48 to remove the narrower recited range. Reconsideration and withdrawal of the rejection are respectfully requested.

§103 Rejection of the Claims

Claims 1-6, 17, 21, 31-36, and 38-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bohner* (WO 0141824) in view of *Rhee* (U.S. 5,510,418) and further in view of *Coombes* (U.S. 5,290,494) and *Lee* (U.S. 6,117,456).

Claims 1-6, 9-10, 17, 21, 31-36, and 38-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bohner* WO 0141824 in view of *Rhee* (U.S. 5,510,418) and further in view of *Starling* (U.S. 6,210,715), *Coombes* (U.S. 5,290,494) and *Lee* (U.S. 6,117,456).

Applicant respectfully submits that the claims are distinguishable over the cited references for at least the following reasons. The rejections are all based on the *Bohner* reference. In discussing *Bohner*, the rejection states that *Bohner* discloses granules in a solution of hyaluronic acid. Applicant respectfully submits that hyaluronic acid is not the same as a hydrogel, as recited in the present claims. A hydrogel microstructure requires includes a degree of crosslinking that provides structure and desirable mechanical properties. Applicant respectfully submits that the additional references of *Rhee*, *Coombes*, and *Lee* fail to cure this deficiency of *Bohner*. In contrast to *Bohner*, claim 1 recites a hydrogel or a substance that can be swelled into a hydrogel.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to independent claim 1. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on an allowable base claim.

Claims 1-6, 17, 21, 31-36, and 38-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dorigatti* (20010053938) in view of *Rhee* (U.S. 5,510,418), and further in view of *Li* (20020187104) and *Coombes* (U.S. 5,290,494) and *Lee* (U.S. 6,117,456).

Claims 1-6, 9-10, 17, 21, 31-36, and 38-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dorigatti* (20010053938) in view of *Rhee* (U.S. 5,510,418), and further in view of *Starling* (U.S. 6,210,715) and *Coombes* (U.S. 5,290,494) and *Lee* (U.S. 6,117,456).

Similar to the arguments presented above, Applicant respectfully submits that the claims are distinguishable over the cited references for at least the following reasons. The rejections are all based on the *Dorigatti* reference. Applicant is also unable to find in *Dorigatti* any reference to a hydrogel or a substance that can be swelled into a hydrogel. The additional references of *Rhee*,

Li, Coombes, and Lee fail to cure this deficiency of Dorigatti. In contrast to Dorigatti, claim 1 recites a hydrogel or a substance that can be swelled into a hydrogel.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to independent claim 1. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on an allowable base claim.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 2/15/2010

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of February 2010.

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Name

Signature

